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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,596	06/29/2001	Matthew Biondi	3350-102	6504

7590

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EXAMINER
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APPLE, KIRSTEN SACHWITZ

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/893,596

Applicant(s)

BIONDI ET AL.

Examiner

Kirsten S. Apple

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## Detailed Action

This action is in response to the application filed on 06/29/2001.

### *Priority*

No claim for priority has been made in this application.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular claims 8 & 11 (9, 10 & 12 are dependent from 8) are indefinite with regards to "failure report." It is unclear to the examiner and one of ordinary skill in the art what is claim by this description. For the purposes of this review the examiner will interpret claim 8 & 11 to be "failure report of losses")

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallman (U.S. Patent 6,161,098) in view of Frank (U.S. Patent 6,240,399 B1.)

**Re claim 1:** Wallman discloses:

*A method for generating a securities trading proposal, comprising:*

*Generating a trading proposal, (see Wallman, Figure 5)*

*For tax lots of a single security across a plurality of accounts (see Wallman, column 7, line 21-24, "tax consequence from trading multiple assets")*

Although Wallman does not specifically have inputting selection criterion (although Wallman alludes to it in Figure 2), Frank clearly shows "selection criterion" in Figure 1, item 24.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to add selection criteria as taught in Frank to Wallman.

It is clear that one would be motivated to give control and input to the user.

**Re claim 2:** Wallman discloses:

*Inputted selection criteria include:*

*i) identification of a single security (see Wallman, Fig 2, "security")*

*II) identification of criteria corresponding to the tax lots (see Wallman, column 3, line 18-21, "tax based on ... securities")*

*iii) identification of criteria corresponding to the plurality of accounts (see Wallman, column 7, line 21-24, "tax consequence from trading multiple assets")*

**Re claim 3:** Wallman discloses:

*Include tax filter rules (see Wallman, Figure 5, "capital tax gain")*

*& gain/loss rules (see Wallman, Figure 4, "capital gain")*

**Re claim 4:** Wallman discloses:

*Tax filter rules Include short-term rollover criterion and wash sale criterion (see Wallman, column 14, line 63-69, "takes into account tax rules")*

**Re claim 5:** Wallman discloses:

*Gain/loss rules based on cost, gain, loss and tax liability (see Wallman, column 9, line 8-16 "means for distinguishing... capital gain and loss")*

**Re claim 6:** Wallman discloses:

*Account criteria include one of selecting as the plurality of accounts all accounts for which account profiles are maintained and selecting the plurality of accounts from the accounts for which account profiles are maintained based on selected account profile information. (see Wallman, column 3, line 40-41 "plurality of assets/liabilities")*

**Re claim 7:** Wallman discloses:

*Receiving:*

*security price information (see Wallman, Figure 2, "current price")*

*tax rate information (see Wallman, column 6, line 46 "tax rate of the user")*

*generating trading proposals including gain/loss, applying selection criteria (see Wallman, Figure 2, "current price")*

**Re claim 8:** Wallman discloses:

*Output trading proposal & failure report (see Wallman, column 4, line 49-55 "outputting a list of assets/liabilities to sell")*

**Re claim 9:** Wallman discloses:

*Generating & transmitting reminders of tax lots & failure reports of losses (see Wallman, column 3, line 46-48 "displaying" the examiner claims Official Notice that one of ordinary skill*

*in art at the time of the invention would be able to turn displaying into a push form of transmitting reminders.)*

**Re claim 10:** Wallman discloses:

*Generating reminders of failed tax lots user selected (see Wallman, column 3, line 46-48 "displaying" the examiner claims Official Notice that one of ordinary skill in art at the time of the invention would be able to turn displaying into a push form of transmitting reminders.)*

**Re claim 11:** Wallman discloses:

*Moving a tax lot identified in a failure report of losses to the trading proposal (see Wallman, Figure 5)*

**Re claim 12:** Wallman discloses:

*Format and content of failure report selectable (see Wallman, Figure 5, the failure report would include everything to the left of the axis)*

**Re claim 13:** Wallman discloses:

*Format and content of trading proposal selectable (see Wallman, Figure 2, by clicking on any part of the graph a trading proposal will appear)*

#### **Re Claims 14-39**

The method claims 1-13 are similar to the article of manufacturing claims 14-26 and system claims 27-39. It would be obvious to one of ordinary skill in the art that these claim have similar limitation. Therefore, claims 14-26 & 27-39 are rejected based on the information provided regarding claims 1-13.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wallman, U.S. Patent 6,516,303 B1, teaches method for management of taxable events.

Gottstein, U.S. Patent No 6,115,697, discloses computerized system and method to process financial securities optimizing after-tax proceeds.

Schulz et al., U.S. Patent 6,687,681 B1, teaches a method and apparatus for automatically managing investment portfolios and to automatically harvest tax losses.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

  
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